

REMARKS

Applicants hereby amend claims 1-36, 41, 44, 45, 49, and 50 and adds claims 51-53. Claims 1-53 are pending in the application, with claims 1, 23, 30, 34, 41, 45, and 51 being in independent form.

In the Office Action dated October 14, 2008¹, the Examiner rejected claims 1-50² under 35 U.S.C. § 103(a) as being unpatentable over WO 01/48678 A1 to Andersson et al. ("*Andersson*") in view of U.S. Patent No. 6,958,747³ B2 to Sahlberg et al. ("*Sahlberg*").

Rejection of Claims 1-50 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-50 under 35 U.S.C. § 103(a) over *Andersson* in view of *Sahlberg*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² Although page 2 of the Office Action indicates that only claim 1 was rejected under 35 U.S.C. § 103(a), pages 3-12 of the Office Action as well as the Office Action Summary suggest that the Examiner also intended to reject claims 2-50 and Applicants have responded accordingly. If Applicants' assumption is incorrect, Applicants request that the Examiner notify Applicants' representative.

³ Applicants note that the Examiner cited to U.S. Patent No. 6,958,757 on page 2 of the Office Action but U.S. Patent No. 6,958,747 in the Notice of References cited. Applicants assume the Examiner intended to cite to U.S. Patent No. 6,958,747 and have responded accordingly. If Applicants' assumption is incorrect, Applicants request that the Examiner notify Applicants' representative.

conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145.

Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. See M.P.E.P. § 2143.01(III), internal citation omitted (emphasis in original). Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Applicants’ claim 1, as amended, recites an information processing system including, amongst other elements, “an allocation unit configured to assign on command, from a position data bank, position data for a current graphical object, and to provide allocation data which associates said assigned position data with the current graphical object.” The Office Action concedes that “*Andersson* does not teach an allocation unit.” Office Action at 2.

Citing to column 2, lines 18-29 of *Sahlberg*, the Office Action indicates that
“*Sahlberg* teaches an allocation unit that produces position data for a graphical object.”

Office Action at 2. The cited excerpt of *Sahlberg* states:

According to an aspect of the invention, a method is provided for developing a product that has at least one activation area which is provided with a position code that codes at least one position on an imaginary surface, which position causes a device that detects the position code to initiate an operation that utilizes the position recorded by the device. The method is characterized by the step of producing a digital representation of at least part of the product, which representation comprises image points, each image point in the digital representation of the activation area corresponding to a position on the imaginary surface.

Even if *Sahlberg* were to teach “produc[ing] position data for a graphical object,” the mere production of position data does not teach or suggest the assignment of position data on command.

Sahlberg teaches a “method and a computer program . . . for developing a product (110) . . . which product has at least one activation area (308) which is provided with a position code (403) that codes at least one position on an imaginary surface (601).” *Sahlberg* at Abstract. *Sahlberg* also teaches that a “digital representation of at least part of the product comprising image points is produced” and that “[o]n the digital representation . . . there is a position code.” *Id.* at Abstract, col. 7, ll. 57-58. As such, *Sahlberg*’s product and digital representation of part of the product are each already provided with position code in one or more areas. Thus, there is no teaching or suggestion of the claimed “allocation unit” that is “configured to assign **on command**, from a position data bank, position data for a current graphical object, and to provide

allocation data which associates said assigned position data with the current graphical object” as recited in amended claim 1 (emphasis added).

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Furthermore, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a).

Independent claims 23 and 30, although of different scope from independent claim 1 and from each other, include recitations similar to independent claim 1. Similarly, although different from claims 1, 23, and 30, independent claim 34 recites a method including a step of “assigning from a position data bank position data for the current graphical object **in response to a command.**” (Emphasis added.)

Independent claims 41 and 45 are different in scope from claim 34 and from each other, but also include similar recitations. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 23, 30, 34, 41, and 45 for at least reasons similar to those provided above with respect to claim 1. Therefore, the Examiner should also withdraw the rejection of independent claims 23, 30, 34, 41, and 45 under 35 U.S.C. § 103(a).

Dependent claims 2-22, 24-29, 31-33, 35-40, and 46-50 depend from one of independent claims 1, 23, 30, 34, 41, and 45. Accordingly, a *prima facie* case of obviousness has not been established with respect to the dependent claims. Therefore,

the Examiner should withdraw the rejection of the dependent claims under 35 U.S.C. § 103(a) at least due to their dependence.

New claims 51-53

Applicants have added new claims 51-53, which are patentable for at least reasons similar to those previously discussed. For example, new independent claim 51, somewhat like claim 1, recites “an interface configured to receive a user command selecting from the first memory at least one graphical object to which position data is to be assigned.” As discussed previously, none of the references of record teach or suggest the unique combination of claim 51, including an interface configured to receive a user command selecting a graphical object for assignment of position data. In addition claim 51 further recites “a processor configured to assign position data from the second memory to the at least one graphical object selected by the user.” Again, the art of record fails to suggest this claim’s unique combination. Therefore, claim 51 is allowable over the prior art, and allowance is respectfully requested.

Dependent claim 52 further recites that “the interface is configured to permit a user to assign position data to at least part of the page of information.” The prior art of record does not teach or suggest an interface that permits the assignment of position data to a page of information, on command of a user, as is recited in the unique combination of claim 52. Therefore, allowance of claim 52 is earnestly requested.

Finally, dependant claim 53 specifies that “the page of information initially lack position data,” and “the interface is configured to permit a user to cause the processor to assign position data to the page of information.” Again, this unique combination of claim 53 is absent from the prior art of record.

New claims 51-53 are fully supported by the specification and claims of the original application including, for example, pages 3-4 and 6-10 and 24-25 of the specification. No new matter has been added.

Conclusion

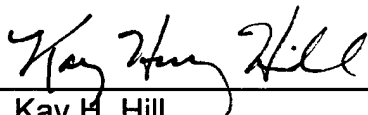
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Kay H. Hill
Reg. No. 62,833
(202) 408-4000